

Argument

Claims 48, 49 and 51-66 have been rejected under 35 U.S.C. §102(b) as being anticipated by Burmesiter, et al. (EP '730). Burmeister, et al. teach shape memory or superelastic stent devices which expand in response to being exposed to a given transition temperature. What is crucial to note is that in this reference, the stent itself is made up a bi-layer structure, with one of the layers being entirely austenitic and the other layer being entirely martensitic. Thus, under a given temperature condition, one of the two layers, but not both, will undergo a phase transformation in response to the given temperature condition. It is the stent structure itself which, therefore, forms the sensor element, not two distinct groups of structural members, each with its own sensor element as presently claimed.

Background of the Law:

In order to establish proper anticipation under 35 U.S.C. §102, each and every element of the claimed invention must be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The claimed elements either be inherent or disclosed expressly in the single prior art reference *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988) and must be arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). The absence from the reference of any claimed element necessarily negates anticipation. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 220 USPQ 81 (Fed. Cir. 1986).

Remarks:

Applicant has amended the pending claims to further clarify in base claim 48 that the inventive device is comprised of "a plurality of structural elements capable of expanding within an anatomical passageway comprising first and second structural elements where" ... at least some of the first structural elements "further comprise at least one first sensor element" and ... "at least some of the plurality of second structural elements further comprise at least one second sensor element" ... "both sensors which ... detect an energy stimulus and respond ... by altering the geometry or conformational

profile of the device...." Thus, the pending claims positively recite that the stent structure is comprised of at least two groups of structural members, each group containing a sensor element distinct from that of the other group. Thus, the sensor elements do not form part of the stent structure itself. Since the Burmeister reference does not teach, either expressly or implicitly, a sensor device in which at least two groups of structural elements have their own distinctive sensor element, as presently claimed, the Examiner's reliance on the Burmeister to support the anticipation rejection is inappropriate.

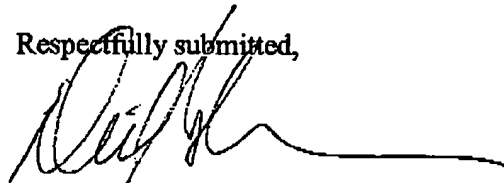
Summary:

Accordingly, Applicant submits that the pending claims are patentability distinct from and over the art cited and of record. Favorable reconsideration of the rejection of the pending claims is solicited.

This Amendment is being concurrently filed with an Amendment Transmittal Letter including a fee calculation sheet, any applicable Request For Extension, and fee calculations. The Director is authorized to deduct any additional expenses from Deposit Account No: 18-2000, of which the undersigned is an authorized signatory.

Should the Examiner find that there are any outstanding matters which are susceptible of resolution by telephone interview, the Examiner is invited to telephone the undersigned to discuss the same.

Respectfully submitted,



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